

Application No. 10/802,906
Amendment dated October 14, 2008

REMARKS

Applicant cancelled claim 43 without prejudice or disclaimer of its subject matter, and amended claims 7, 9, 42, 44, 45, 47, and 48 to further define Applicant's claimed invention.

I. 35 U.S.C. § 112, First Paragraph Rejection

In the Office Action of April 08, 2008 ("Office Action"), the Examiner rejected claims 7-51 (including independent claims 7, 42, and 47) under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement because independent claim 7 recited "a locking element...being moveable without deformation," independent claim 42 recited "a non-elastic locking element," and independent claim 47 recited "a locking element" with at least a portion thereof "being rigid." Applicant maintains that, contrary to the Examiner's assertions, independent claims 7, 42, and 47 including the above-listed recitations are fully supported in the specification so as to reasonably convey the claimed invention to one skilled in the relevant art that the Applicant, at the time the application was filed, had possession of the claimed invention. Nevertheless, to expedite prosecution of the present application, Applicant has amended independent claims 7, 42, and 47, and claims depending therefrom, to remove the above-listed recitations. Accordingly, Applicant submits that the rejection of amended independent claims 7, 42, and 47 under 35 U.S.C. § 112, first paragraph, is rendered moot. Applicant reserves the right to pursue the subject matter deleted from the claims in a future application without prejudice or disclaimer of the subject matter.

II. 35 U.S.C. § 103(a) Rejections

The Examiner rejected claims 7-10, 13-16, and 18-51 (including independent claims 7, 42, and 47) under 35 U.S.C. § 103(a) based on U.S. Patent No. 2,825,329 to Caesar ("Caesar"); and rejected claims 7-41 (including independent claim 7) under 35 U.S.C. § 103(a) based on U.S. Patent No. 4,488,543 to Tornier ("Tornier"). As discussed below, Applicant submits that amended independent claims 7, 42, and 47, as amended, overcome the Examiner's rejections under 35 U.S.C. § 103(a).

Even under the obviousness guidelines outlined in Graham et al. v. John Deere Co. of Kansas City et al., 383 U.S. 1, 148 U.S.P.Q. 459 (1966), and affirmed in KSR v.

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Teleflex, 127 S.Ct. 1727 (2007), a combination of references that does not teach or suggest every element of the claimed invention, or references that teach away from the claimed invention support a finding of nonobviousness. As discussed below, Caesar and Tornier both do not teach each and every element, and, in fact, teach away from the claimed invention.

Although Applicant strongly maintains that the Examiner's interpretation of the term "coupled" is erroneous, independent claims 7, 42, and 47 have been amended to expedite prosecution of the present application. Applicant makes no disclaimer or disavowal of the term "coupled," and preserves the right to an unencumbered definition of the term in this or any other applications and patents without prejudice. As amended, independent claims 7, 42, and 47 (rather than using the term "coupled") recite a locking element "being moveably attached to said implant prior to the insertion" "of the bone screws into said bone screw receiving holes" (claims 7 and 47), and "of said at least two bone screws into said at least two bone screw receiving holes" (claim 42). Applicant submits that placing a plate and a locking element into a sterile package does not attach, let alone moveably attach, the plate and the locking element referenced by the Examiner to one another. Moreover, Applicant respectfully submits that it is an improper interpretation of the term "coupled," as used in the rejected claims, as covering uncoupled components placed in the same package. Furthermore, as discussed below, Caesar and Tornier do not teach or suggest a locking element being attached to the implant prior to the insertion of the bone screws.

A. Obviousness rejection based on Caesar

Regarding Caesar, Applicant submits that a second plate 150 and a plate 140 thereof are attached to one another as a result of, not prior to, the insertion of bone screws 158 into openings 156 of the second plate 150 and openings 146 of the plate 140. As such, Caesar does not teach or suggest a locking element "being moveably attached to said implant prior to the insertion of the bone screws into said bone screw receiving holes," as recited in amended independent claims 7 and 47. Furthermore, Caesar does not teach or suggest a locking element "being moveably attached to said

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implant prior to the insertion of said at least two bone screws into said at least two bone screw receiving holes," as recited in amended independent claim 42.

Furthermore, Applicant submits that Caesar actually teaches away from the claimed invention as recited in amended independent claims 7, 42, and 47. Because the second plate 150 is attached to the plate 140 only after bone screws 158 are inserted into the openings 156 of the second plate 150 and into the openings 146 of the plate 140, Caesar teaches away from attaching a locking element to an implant prior to the insertion of the bone screws into the bone screw receiving holes.

Accordingly, Caesar does not teach or suggest each and every element, and, in fact, teaches away from the claimed invention. Therefore, Applicant submits that the Examiner's rejection of amended independent claims 7, 42, and 47 based on Caesar cannot be maintained. As such, the Examiner's rejection of claims 7-10, 13-16, and 18-51 under 35 U.S.C. § 103(a) based on Caesar has been overcome.

A. Obviousness rejection based on Tornier

Tornier teaches a disc 11 that "has centrally between the three holes a diameter which partially covers each of heads 3a of screws 3 to assure their being held in corresponding holes 6." (Tornier, col. 2, lines 37-40.) Since the disc 11 covers the heads 3a of the screws 3, Applicant submits that the disc 11 of Tornier is attached to the plate 2 after the insertion of the bone screws 3 into the bone screw receiving holes 6. Tornier also teaches that the disk 11 "is elastic thereby making possible the passage of heads 3a of screws 3 and the backward movements of the screws 3, in the event that they come in contact with the cortical of the femoral head." (Tornier, col. 2, lines 44-48.)

As discussed above, amended independent claim 7 recites a locking element "being moveably attached to said implant prior to the insertion of the bone screws into said bone screw receiving holes." Additionally, amended independent claim 7 recites that that the locking element is moveable from an initial position to a final position, "said locking element in said final position preventing withdrawal of the at least one bone screw from said one of said bone screw receiving holes."

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Given that the disc 11 of Tornier is attached to the plate 2 after the insertion of the screws 3 into the corresponding holes 6 and that the disc 11 affords backward movement of the screws 3 out of their corresponding holes 6, Tornier (unlike amended independent claim 7) does not both teach or suggest (1) a locking element moveably attached to an implant prior to the insertion of the bone screws into the bone screw receiving holes, and (2) a locking element moveable from an initial position to a final position that prevents withdrawal of the bone screw from the bone screw receiving hole in the final position. Furthermore, because the disc 11 is attached to the plate 2 after the insertion of the bone screws 3 into the corresponding holes 6, and the disc 11 affords backward movement of the screws 3 out of their corresponding holes 6, Tornier, like Caesar, actually teaches away from the claimed invention of independent claim 7.

Accordingly, because Tornier does not teach or suggest each and every element, and, in fact, teaches away from the claimed invention, Applicant submits that the Examiner's rejection of independent claim 7 based on Tornier cannot be maintained. As such, the Examiner's rejection of claims 7-41 under 35 U.S.C. § 103(a) based on Tornier has been overcome.

Applicant submits that independent claims 7, 42, and 47 are patentable over the Examiner's rejections under 35 U.S.C. § 103(a), and that claims 8-41, 44-46, and 48-51 are allowable at least because these claims depend from an allowable independent claim, or claims dependent therefrom.

III. Double Patenting Rejections

The Examiner rejected claims 7-51 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-173 of U.S. Patent No. 6,193,721 ("721 patent"), claims 1-39 of U.S. Patent No. 6,936,051 ("051 patent"), and claims 1-117 of U.S. Patent No. 6,398,783 ("783 patent"), in view of U.S. Patent No. 5,468,242 ("242 patent"). The Examiner provisionally rejected claims 7-51 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-72 of copending U.S. Patent Application No. 10/926,734 ("734 application") and claims 1-62 of copending U.S. Patent Application No. 11/128,556 ("556 application") in view of the "242 patent".

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Applicant respectfully disagrees with the Examiner's double patenting rejections over the '721, the '051, and the '783 patents at least for the reasons discussed on pages 11-14 of the Amendment dated November 30, 2007. However, in the interest of expediting the prosecution of this application, Applicant acknowledges the Examiner's obviousness-type double patenting rejections and reserves the right to address the double patenting rejections upon allowance of the claims in one of the present application, the '734 application, and the '556 application to determine if a Terminal Disclaimer is required at that time.

IV. Conclusion

In conclusion, Applicant submits that Independent claims 7, 42, and 47 are patentable and that dependent claims 8-41, 44-46, and 48-51 dependent from independent claims 7, 42, and 47, or claims dependent therefrom, are patentable at least due to their dependency from an allowable independent claim.

Entry and consideration of this Amendment prior to the further examination of the above-identified application is respectfully requested.

To the extent any extension of time under 37 C.F.R. § 1.136 is required to obtain entry of this reply, such extension is hereby respectfully requested. If there are any fees due under 37 C.F.R. §§ 1.16 or 1.17 which are not enclosed herewith, including any fees required for an extension of time under 37 C.F.R. § 1.136, please charge such fees to our Deposit Account No. 50-3726.

Respectfully submitted,

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